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EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/607,202

**Applicant(s)**

JAKUBAITIS, FRANK J.

**Examiner**

Robert M. Pond

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-9 and 12-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,4-9 and 12-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant filed after-final remarks with amended claims. The Applicant amended Claims 1, 7, and 9, and canceled Claims 15-19. All pending claims (1, 4-9, and 12-15) were examined in this final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Rejection under 35 USC 103**

Applicant's arguments, see Remarks, filed 24 February 2005, with respect to the rejection(s) of claim(s) 1, 4-9, and 12-15 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Reber, and Fiala, and Freeny as necessitated by amendment. Reber teaches a system and method for accessing digital content- audible, visual, textual, animation file, movie file, audio file- over the Internet and World Wide Web as specified by a URL address, or path/file name, or electronic address, or other resource location identifier. Reber teaches authenticating access usage based the customer's possession of a card with identifying information and description of goods or services to be accessed as a limited one-time use, or metering multiple uses or time duration access. Reber specifically teaches

embodiments implementing one-time prepaid usage, marketing content access cards in stores, and delivering digital content to a personal computer remotely connect to the Internet. Fiala teaches a system and method of activating a metered account managed by a remote computer from retail point-of-sale systems using a prepaid card purchased by a customer at a merchant location. Freeny teaches a consumer prepaying for digital content using a computer remotely connected to a computer managing and distributing online content, delivering content via a consumer's home electronic systems, and the consumer's home as a point of sale location. Freeny further teaches transmitting purchased content to a reproduction unit that stores the purchased content onto a recordable medium for customer off-line use and controlling the usage of the recordable medium to prevent piracy and protect copyright terms.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1, 6-9, and 13-19 are rejected under 35 USC 103(a) as being unpatentable over Reber et al. (US 5,995,105 hereinafter referred to as "Reber") in view of Fiala et al. (Paper #4, US 5,918,909 hereinafter referred to as "Fiala") and Freeny, Jr. (US 4,528,643 hereinafter referred to as "Freeny").**

Reber teaches a system and method for accessing content-audible, visual, textual, animation file, movie file, audio file- over the Internet and World Wide Web as specified by a URL address, or path/file name, or electronic address, or other resource location identifier (please note: Reber inherently discloses the structures that permit the transmission of digital content). Reber teaches access authenticating access usage as a limited one-time use, or multiple uses, or flat rate, or time duration, and teaches embodiments well suited for limited prepaid use (see at least Fig. 1 (10, 22, 28, 32); Fig. 2; Fig. 11; col. 2, lines 35-56; col. 2, line 57 through col. 5, line 53; col. 11, lines 29-39; col. 12, line 57 through col. 14, line 2). Reber further teaches:

- card identifier, identifier displayed on outer surface; identifier being a code; uniquely identifies goods or services being purchased: bar coded identifier for accessing goods or service including textual identifiers (see at least Fig. 2 (46); col. 5, line 59 through col. 6, line 44).
- outer surface of the card displaying a description of the content of the goods or services: human viewable descriptive material indicative of goods or services (see at least col. 3, line 63 through col. 4, line 17).
- remote server receiving the request; searching good or services stored on the remote server for the desired goods or services specified by the package identifier; setting the status of the desired goods or services as available for access: customer access prepaid content (see at least Fig. 9 (120); col. 11, lines 28-40).
- sending a request to access the desired goods or services from the customer node through the communications network; specifying the desired goods or services identification data; receiving at the remote server the request: sending a request; password used to gain access; password uniquely identifies card (see at least col. 7, line 64 through col. 8, line 14).
- identifying the goods or services based upon the received identification data: (see at least Fig. 8 (118, 120).
- packaging options: account being exposed on the outer surface (textual); magnetic stripe with encoded identification information; barcode account

information (see at least Fig. 1 (10); Fig. 2 (46); Fig. 6 (72); col. 8, lines 15-25); obscuring information (see at least Fig. 12; Fig. 13; col. 3, lines 43-51; col. 13, lines 23-30).

- Logic and control: (see at least Fig. 9 (110-112); Fig. 11 (150)).

Reber teaches all the above as noted under the 103(a) rejection and teaches a) prepaying for limited use access to digital content over the Internet and World Wide Web, b) using a card to access the limited use digital content over the Internet and World Wide Web, c) marketing the card in stores, and further teaches monitoring content access based on time duration or multiple uses (please note examiner's interpretation: metering). Reber, however, does not disclose purchasing from a retail merchant a card associated with desired goods or services. Fiala teaches a package for holding a data encoded card associated with a metered account, displaying the package/card on a merchant's display rack, and a package-card arrangement depicting the card as integral part of the package (see at least Fig. 1 (30, c); col. 2, lines 2-26; col. 4, lines 58-62; col. 5, lines 8-10). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber to disclose purchasing from a retail merchant a package including a card associated with desired goods or services as taught by Fiala, in order to provide a purchasing mechanism for the prepaid card, and thereby attract customers to the store and service willing to pay for prepaid access to digital content.

Reber teaches all the above as noted under the 103(a) rejection as noted above, but does not disclose sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired goods or services as available for access based on the package identifier. Fiala teaches all the above as noted under the 103(a) rejection and teaches a) a remote computer is electronically linked to merchant locations wherein characterization information is read at merchant location and transmitted to the remote computer to activate the metered account (please note examiner's interpretation: activating the account provides an indication of availability) (see at least col. 19, lines 29-44; col. 19, line 64 through col. 20, line 5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber to implement retailer activation as taught by Fiala, in order to activate the prepaid card sold by the retailer, and thereby enable customers to access digital content sold through the retail establishment.

Reber and Fiala teach all the above as noted under the 103(a) rejection and teach a) accessing prepaid digital content using the Internet and World Wide Web, b) the customer receiving accessed digital content on a computer display device, and c) the customer prepaying for digital content, but do not disclose storing the accessed content for off-line use. Freeny teaches consumers prepaying for digital content using a computer remotely connected to a computer managing and distributing online content, delivering content to a consumer's home electronic systems, and further teaches the consumer's home as a point of



sale location. Freeny teaches transmitting purchased content to a reproduction unit that stores the purchased content onto a recordable medium for customer off-line use and controlling the usage of the recordable medium to prevent piracy and protect copyright terms (see at least abstract; Fig. 4 (24, 34, 110); col. 3, line 25 through col. 4, line 19; col. 4, line 36 through col. 5, line 50; col. 26, lines 28 through col. 28, line 15). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Reber and Fiala to implement downloadable content to a storage medium as taught by Freeny, in order to provide off-line content usage, and thereby attract customers to the retail store and online content distribution service.

*Pertaining to system Claims 9 and 13-15*

Rejections of Claims 9 and 13-15 are based upon the same rationale as noted above.

2. **Claims 4 and 12 are rejected under 35 USC 103(a) as being unpatentable over Reber (US 5,995,105), and Fiala (Paper #4, US 5,918,909) and Freeny (US 4,528,643), as applied to Claims 1 and 9, further in view of Official Notice (Paper #16, admitted as prior art regarding ordinary skill in the art).**

Reber, and Fiala and Freeny teach all the above as noted under the 103(a) rejection and teach a) folded variants to obscure a subset of human readable information on a substrate, b) PIN numbers packaged as being obscured and exposed with unique identifiers packaged as fully exposed or partially exposed,

and c) applying a sticker to obscure the PIN, but do not disclose the unique identifier packaged as being obscured. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Reber, and Fiala and Freeny to disclose fully obscuring the unique identifier with an obscured PIN, since one of ordinary skill in the art would ascertain the identifier could be fully obscured with the techniques disclosed, and thereby provide additional account protection.

Pertaining to system Claim 12

Rejection of Claim 12 is based upon the same rationale as noted above.

3. **Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Reber (US 5,995,105), and Fiala (Paper #4, US 5,918,909) and Freeny (US 4,528,643), as applied to Claim 1, further in view of White et al. (Paper #16, patent number 6,169,975 hereinafter referred to as "White").**

Reber, and Fiala and Freeny teach all the above as noted under the 103(a) rejection and teach a) consumers purchasing a package containing a prepaid card with a personal access code used to gain access to services and digital information, but do not disclose printing a PIN number for the consumer. White teaches consumers purchasing a prepaid card for services at a point-of-distribution, a prepaid card containing a magnetic strip for reading, and further teaches printing the PIN for the consumer on a paper receipt (see at least abstract; col. 2, lines 23-40). Therefore it would have been obvious to one of

ordinary skill in the art to modify the method of Reber, and Fiala and Freeny to disclose printing a receipt containing the PIN as taught by White, in order for the consumer to know what number is valid for the prepaid card.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond  
Primary Examiner  
25 March 2005